



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/614,945 | 07/12/2000 | Witold Kula | SJO9-2000--0043US1 | 2508 |

30869 7590 05/10/2004

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
2345 YALE STREET, 2ND FLOOR
PALO ALTO, CA 94306

EXAMINER

HEINZ, ALLEN J

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 05/10/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/614,945

Applicant(s)

KULA, WITOLD

Examiner

A. J. HEINZ

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 4-12 and 25-33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2653

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C § 121:

Group I; Claims 13-21 are drawn to a method of manufacturing a magnetic head, classified in Class 29, subclass 603.14.

Group II; Claims 1-12 and 22-33 are drawn to a magnetic head, classified in Class 360, subclass 324.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the magnetic head can be fabricated using steps which do not follow the same chronological order of the claimed steps and/or may omit certain of the steps or may substitute certain steps; e.g. the sputtering step of Cl.13 can be replaced with a vapor deposition process step.

Art Unit: 2653

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and require divergent fields of search, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. M. Alboshta on 01 March 2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 1-12 and 22-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

**An action on the patentable merits of the
elected claims follows herein.**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2653

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-3,22-24 are rejected under 35 U.S.C. §102(e) as being anticipated by Horng.

See Fig. 1 and the Specification, col.7, line 52 thru col.8, line 27.

6. Claims 4-12 and 25-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2653

7. For a complete response applicant should identify how the claimed structure of his invention defines over **all** the art of record.

Moreover, where the applicant disagrees with the reasoning and/or application of the prior art on critical points of the claims, they should identify how the claimed structure of their invention defines over **all** the art of record not just the applied art.

Where applicant believes that the art is redundant and/or superfluous relative to the critical aspects of the claimed invention the applicant may simply state so in rebuttal summary.

8. If applicant has filed an information disclosure statement prior to one month before the mailing date of this office action and this instant office action does not contain an initialed-off copy (or copies) of all the filed IDS's or at least a comment to the disposition of such IDS'S in the body of the office action itself, applicant should apprise the examiner of such missing documentation(to the IDS's) in response to this office action so that the examiner can take appropriate action to supply same to the applicant.

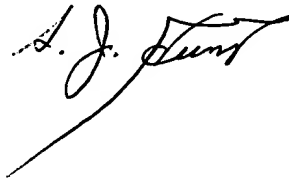
Art Unit: 2653

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. J. HEINZ whose telephone number is (703) 308-1544. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM KORZUCH can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A. J. HEINZ
Primary Examiner
Art Unit 2653

A handwritten signature in black ink, appearing to read 'A. J. Heinz', with a long, sweeping underline that extends to the left and then curves back towards the right.